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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,983	06/14/2001	Isaac K. Elliott	VON96046C1	6036

25537 7590 07/24/2006

VERIZON
PATENT MANAGEMENT GROUP
1515 N. COURTHOUSE ROAD
SUITE 500
ARLINGTON, VA 22201-2909

EXAMINER

PHAN, MAN U

ART UNIT PAPER NUMBER

2616

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/879,983	Applicant(s) ELLIOTT ET AL.	
	Examiner Man Phan	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment and Argument

1. This communication is in response to applicant's 05/25/2006 response in the application of Elliott et al. for a "System and method for providing requested quality of service in a hybrid network" filed 06/14/2001. This application is a continuation of US Application 08/751,917 filed November 18, 1996 is now US Patent# 6,335,927. The amendment and response has been entered and made of record. Claims 1-11 are pending in the application.
2. Applicant's amendment and argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C. 103 as discussed below. Applicant's argument with respect to the pending claims have been fully considered, but they are not persuasive for at least the following reasons.
3. Applicant's argument with respect to the rejected claims that the cited references Alfred et al. (US#6,278,693) and Nagami et al. (US#6,515,999) are not prior art with respect to the present application, based on M.P.E.P 706.02 (f)(1) (Page 2, last paragraph). However, MPEP § 706.02 regarding determination of effective filing date of the application under 35 U.S.C 102(e), and not under 35 U.S.C 103(a) as presented in the office action. Applicant should be aware that although a publication of, or a U.S. Patent issued from, an international application may not have a 35 U.S.C. 102(e) date at all, or may have a 35 U.S.C. 102(e) date that is after the effective filing date of the application being examined (so it is not "prior art"), the corresponding WIPO publication of an international application may have an earlier 35 U.S.C. 102(a) or (b) date.

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102(a), Activity by Another Before Invention by Applicant: (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. 102(b), Activity More Than One Year Prior to Filing: (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Furthermore, In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title (priority under 35 USC 119), a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States (*35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application*).

Applicant's argument with respect to the rejected claims (pages 3, last 2 paragraph) that claims 1-4 and 7-9 stand rejected under the judicially created doctrine of obviousness-type double patenting. However, as stated in the remark of the last Office Action that the Final rejections mailed November 08, 2005 has been withdrawn, and not the same office action was mailed on February 28, 2006. In summary, Claims **1, 5-8 and 10-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldred et al. (US#6,278,693) in view of Nagami et al. (US#6,515,999), and Claims **2-4 and 9** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,335,927. Therefore, the Examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

Claim Rejections - 35 USC ' 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 1038 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 5-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldred et al. (US#6,278,693) in view of Nagami et al. (US#6,515,999).

Regarding claims 1, 5-8 and 10-11, Aldred et al. (US#6,278,693) and Nagami et al. (US#6,515,999) disclose a novel system and method for responding to requests for quality of services and reserving the resources to provide the requested services, according to the essential

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features of the claims. Aldred provides a communications system for transmitting and/or receiving data over a network, said communications system including means responsive to requests for a desired quality of service specifying at least two quality of service parameters, for determining whether or not the requested quality of service is available, characterised in that said determining means is responsive to quality of service requests specifying the desired quality of service as a logical expression involving two or more of said at least two quality of service parameters. Typically the quality of service requests are received from applications intending to initiate data communications over said network. The determining means then compares the requested quality of service parameters with the facilities provided by the communications link(s) available to the communications system. If a match is obtained, then the requested transmission can be accepted, otherwise it must be refused (Col. 3, lines 50 plus). Aldred further teaches the determining means compares the facilities provided by the communications link(s) available to the communications system with the requested quality of service parameter ranges, to check whether the available resources lie within (ie partially overlap at least) the range for each desired parameter. In the preferred embodiment, this comparison is performed by alternately running the quality of service specifications for the requested and available quality of service until convergence is obtained. This procedure resolves any logical expressions used to specify quality of service; for example, the desired rate or bandwidth may depend on the frame size used, which may be effectively determined by the available communication link. Assuming that the desired quality of service can be satisfied by the available quality of service, an agreed range is produced for each quality of service parameter, effectively representing the overlap of the desired and available ranges for that parameter (Col. 4, lines 42 plus and Col. 13, lines 44

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plus)

In the same field of endeavor, Nagami discloses a router apparatus located at a boundary of logical networks and a method for setting up a virtual connection to transfer packets through the router apparatus. When the destination node receives the PATH message, it notifies its request for resource reservation by sending an RESV message upstream, back to the source node in response to the PATH message. This RESV message contains an identifier that specifies the data for which resources are to be reserved and a quality of service (QOS) requested by the destination node. When a node receives the RESV message, it determines whether its network-layer (e.g., Internet Protocol (IP)) processing unit has sufficient capacity for this resource reservation. If so, the node performs network-layer scheduling to reserve the resources and transfers the RESV message upstream. If not, the node sends an RESV_ERROR message downstream. This procedure is repeated until the RESV message reaches the source node, thereby completing the resource reservation (See Figs. 5, 9; Col. 1, lines 48 plus).

One skilled in the art would have recognized the need for effectively and efficiently providing requested quality of service routing in networks, and would have applied Nagami's novel use of logical networks and a method for setting up a virtual connection to transfer packets through the router apparatus into Aldred's quality of service parameters in network communications. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Nagami et al.'s router apparatus and method of using a virtual connection to transfer a packet into Aldred et al.'s communications systems with quality of service parameters with the motivation being to provide a system and method for providing requested quality of service in a hybrid network.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims **2-4 and 9** of the present application Serial No. 09/879,983 (hereinafter Application '983) rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,335,927 (hereinafter patent '927) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, scope and embodiment reflects identical operation, purpose, application, and environment.

With respect to the specific limitations, The combination of the pending claims 1, 2-4 and 7-9 of Application '983 are equivalent to the claims 1-4 of patent '927.

Furthermore, there is no apparent reason why applicant was prevented from presenting

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claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Conclusion

10. **THIS ACTION THIS ACTION IS MADE FINAL.** See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149.

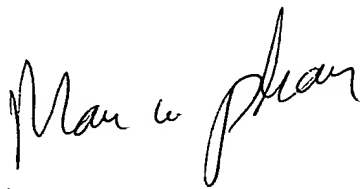
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The examiner can normally be reached on Mon - Fri from 6:00 to 3:00 EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

07/20/2006.

A handwritten signature in black ink, appearing to read "Man U. Phan", written in a cursive style.

**MAN U. PHAN
PRIMARY EXAMINER**